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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,528

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David J. Paul

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EXAMINER

MAI, HAO D

ART UNIT

PAPER NUMBER

3732

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,528	<b>Applicant(s)</b> PAUL ET AL.	
	<b>Examiner</b> HAO D. MAI	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 128-137 and 145-150 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 128-137 and 145-150 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 128-131, 145, and 147-149, are rejected under 35 U.S.C. 102(b) as being anticipated by Sears (3,138,871).**

Regarding claim 128, Sears discloses a device (spoon 1) capable of providing additional stabilization to tissue already contact with a primary stabilization member, the device comprising: a single, substantially rigid, tissue contact member (spoon 1) formed in a unitary, continuous loop (bowl-shaped base 5) and capable of being placed on the tissue in an area bounded by primary tissue contact members, wherein a bottom surface of said contact member includes a contact surface (bottom surface of bowl-shaped base 5) that angles from an exterior portion thereof to an interior portion thereof. The handle 4 serves as a connecting member extending from the tissue contacting member, adapted to be hand held or fixed to a relatively immovable object. As to claims 129-131, the device/spoon 1 has the central opening 6 is capable of allowing access to a target site on the tissue; the base member (bowl 5) is substantially oval-shaped and cants upwardly around an outer perimeter thereof.

Regarding claims 145 and 147-149, Sears disclose all the claimed elements of the inventions as detailed above with respect to claims 128-131.

Note that such claim language "for providing additional stabilization to tissue already in contact with a primary stabilization member" is functional or intended use and does not convey

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positive structural limitation(s). It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham, 2 USPQ2d 1647 (1987)*. If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Hutchison, 69 USPQ 138*.

**3. Claims 128-129, and 147-148, are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor et al. (6036641).**

Regarding claims 128, Taylor et al. disclose a device 1 (Fig. 8) capable of providing additional stabilization to tissue already in contact with a primary stabilization member, the device comprising: a single, substantially rigid tissue contact member 1 (Fig. 8) formed as a unitary continuous loop capable of being placed on the tissue; and a connecting member/handle 3 integrally formed with and extending from the tissue contact member and capable of being hand held or fixed to a relatively immovable object. As to the new added limitations, the device is shown to have a bottom surface that includes a contact surface (area 44) that angles from an exterior portion thereof to an interior portion thereof. Note that either one of the vertical walls of passage 44 is considered to be the exterior portion; the bottom surface between the two vertical walls is considered to be the interior portion; and there is an angle or inclination between either one of the vertical walls and bottom surface there between. As to claim 129, tissue contact member 1 is shown to comprise a base 42 having a central opening therethrough, said central opening is capable of allowing access to a target site on the tissue.

As to claim 147, Taylor et al. disclose all the claimed elements as detailed above with respect to claims 128-129. Note that Figure 8 also shows the base member having an outer perimeter portion 41 that cants upwardly from a lower surface 42 or the bottom surface located

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interiorly of outer perimeter 41; the device is capable of having the lower surface 42 contacting the tissue while the outer perimeter portion 41 contacts the primary stabilization member.

As to claim 148, Taylor et al. disclose all the claimed elements including a contact surface that angles from an exterior portion (perimeter wall 41) to an interior portion (bottom surface), whereby said interior portion of the contact surface is capable of approximate tissue while the exterior portion is capable of contacting upper surfaces of the stabilization member. Note that both the bottom surface and the outer perimeter wall 41 are contacting surfaces as they are capable of contacting tissues.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 130-131, 145, and 149, are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (6036641).**

Taylor et al. disclose the invention substantially including the base member 42 having a contact surface canting upwardly around an outer perimeter thereof, or the bottom surface angles from an exterior portion to an interior portion at area 44. However, Taylor et al. fail to disclose the base member of the tissue contact member being substantially oval-shaped.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Taylor et al. by making the base member of a substantially oval-shaped. Such modification is merely a design choice which a person of ordinary skill in the art

would have found obvious absent persuasive evidence that the particular configuration or shape of the tissue contacting member was significant. MPEP § 2144.04.

**6. Claim 132-137, 146, and 150, are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (6036641) in view of Borst et al. (5836311).**

Taylor et al. disclose the invention substantially as claimed. As to claims 132-134, however, Taylor et al. fail to disclose the base member having a substantially hollow interior being fluidly connected with the handle and having fluidly connected openings through a bottom surface. Borst et al. disclose a base member 81 having substantially hollow interior and integral suction ports/openings 82 at the bottom surface thereof; the hollow interior and the suction ports/openings 82 are capable of developing and applying a negative pressure to the tissue (Fig. 13; column 7 lines 18-41). Figure 13 also shows a connecting member/handle being fluidly connected to the hollow interior of base 81 and is capable of being connected to a source of negative pressure (column 7 lines 18-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Taylor et al. by including the hollow interior with suction ports/openings at the bottom surface, being fluidly connected to the handle which is being connected to a source of negative pressure/suction in order to provide a suction mechanism that suck onto or seal with the tissues, providing a more effective stabilization of the heart.

As to claims 135-137, in an alternative embodiment of Figure 9, Taylor et al. disclose in the base member having openings 147 through an upper surface thereof; the openings being fluidly connected with a lumen 48 that is connectable with a source of pressure; the lumen 148 is shown to run inside the connecting member/handle (column 17 lines 30-42); and in the embodiment of Figure 9C, a manifold is shown to mount inside the base member and fluidly

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connected the lumen with the openings (column 17 lines 51-55). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate to Taylor's embodiment of Figure 8 in combination with Borst's the openings through the upper surface and the lumen providing pressure independent from that of Borst's hollow interior's negative pressure so that the openings through the upper surface having an independent source of pressure (either negative/suction or positive/blowing) can provide a clear and dry surgical site as taught by Taylor et al.

Regarding claims 146 and 150, Taylor and Borst in combination disclose the invention with all the claimed elements as detailed above with respect to claims 128-137.

### ***Response to Arguments***

7. Applicant's arguments filed 09/12/2008 have been fully considered but they are not persuasive and/or moot in view of the new ground(s) of rejection.

Applicant argued that notch/passage 44 of Taylor's device in Figure 8 does not incline from an interior portion to an exterior portion. Note that either one of the vertical walls of notch/passage 44 is considered to be the exterior portion; the bottom surface between the two vertical walls is considered to be the interior portion; and there is an angle or inclination between either one of the vertical walls and bottom surface there between.

Regarding the rejection of claim 147 under Taylor, Applicant argued 42 is not the lower surface of the annular contact member 41 because 42 and 41 are not of one-pieced structure. The examiner maintains that Taylor's device as shown in Figure 8 has a base member 1 having an outer perimeter portion 41 that cants upwardly from a lower surface 42 of said base member located interiorly of said outer perimeter portion 41, albeit structures 42 and 41 not being one-

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pieced. Alternatively, the bottom surface of the base can be considered the lower surface located interiorly of the perimeter portion 41.

As to applicant's arguments regarding the rejection of oval shape and canting upwardly at an outer perimeter under obviousness as being merely a design choice, note that the cited prior arts disclose the canting-upwardly configuration. It was the oval-shape and the cowboy-hat-shape being rejected as obvious design choice(s). In any case, the arguments are moot in view of new ground(s) of rejection since the claim has been amended to omit "the shape of a cowboy hat".

Applicant argued that Taylor and Borst both fail to disclose a device "for providing additional stabilization to tissue already in contact with a primary stabilization member". Note that such claim language is functional or intended use and does not convey positive structural limitation(s). It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). If the prior art structure is capable of performing the intended use, then it meets the claim. *In re Hutchison*, 69 USPQ 138.

It is assumed that the arguments regarding rejection(s) under Borst in view of Wright, and Taylor in view of Wright, were included by mistake. Such rejections were not presented in Office Action of 06/09/2008.

### **Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened



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statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO D. MAI whose telephone number is (571)270-3002. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Hao D Mai/  
Examiner, Art Unit 3732**

/Cris L. Rodriguez/  
Supervisory Patent Examiner, Art Unit 3732